

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Timothy MURPHY

Application No.: 10/770,403

Filing Date: 4 February 2004

For: Methods for Treating Obesity

Art Unit: 3738

Examiner: Prebilic, Paul B.

Attorney Ref. No.: 010-001

Via EFS-Web

RESPONSE TO ADVISORY ACTION

Mail Stop RCE

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Applicant files concurrently herewith a Request for Continued Examination ("RCE"), based on the Response filed on 12 July 2007 and the additional arguments presented herein.

Favorable reconsideration, reexamination, and allowance of this patent application are respectfully requested.

Applicant acknowledges receipt of the Advisory Action dated 23 July 2007 ("Advisory"), which was issued in response to Applicant's July 12th Response. The Advisory refused entry of the evidence that Applicant filed with the Response, and opined on a Continuation Sheet:

The argument pertain [sic] to the new evidence that was not filed in response to a new rejection of the Final Office action. A cursory review of the evidence suggests that the experts were not aware of the patent to Flesler and their knowledge of patents may not be comparable to one of ordinary skill in the art.

With regard to the statement that "the evidence suggests that the experts were not aware of the patent of Fesler and their knowledge might not be comparable to one of ordinary skill in the art", it is certainly true that the individuals who make up the panel of experts are not patent examiners. Indeed, these persons are selected because of their knowledge and experience in their fields, and are assembled to evaluate the technical subject matter for which a grant is requested. If Mr. Prebilic is stating that these experts are not persons of ordinary skill in the art, he should

affirmatively state as such on the record, because this would be an important aspect of his opinion.

On the contrary, however, the individuals who make up the review panel are selected precisely because of their knowledge and expertise in the field, and therefore are at least as skilled and knowledgeable as the hypothetical 'person of ordinary skill in the art'. It should be particularly noted that the pending claims are directed to methods for treating a patient, which is significantly different subject matter from devices which are intended to be used to treat a patient, and carry with them entirely different, and higher, levels of skill in the routineer in the art. The experts on the review panel give a measure of that skill and, at worst, are each merely of ordinary skill in their arts. Considering that they are each appointed by the U.S. government to review grant proposals, among other things to safeguard public safety (which is not at all an issue with which the PTO is concerned), it is plainly the case that these individuals are more skilled and knowledgeable in their fields than the ordinary routineer.

Thus, the panel of true experts, and not of mere routineers in the art, views the invention claimed herein as novel, risky, and even outrageous. With such a view, Applicant respectfully submits that the lowlier 'person of ordinary skill in the art' would be even more adverse to the claimed methods, and would certainly not look to make the *Flesler* method more permanent, fixed, and/or invariable than *Flesler*'s electroshock process already is. Stated somewhat differently and rhetorically, if even a panel of hyper-skilled experts in the field finds the claimed invention to be novel, how is it that the person of ordinary skill in the art would nevertheless find it to be obvious? The answer to that question is, in the final analysis, quite simple: the claimed methods are not obvious variants of the *Flesler* procedures, as evinced by the views of the panel of experts.

The only remaining reason why one would modify *Flesler* in view of *Ruiz*, as alleged in the Office Action to be obvious, is upon an impermissible hindsight reconstruction of the claimed invention from Applicant's own specification, and therefore a *prima facie* case of obviousness has not been made.

For at least the foregoing reasons, Applicant respectfully submits that the subject matters

of Claims 1, 3-6, and 8-14, each taken as a whole, would not have been obvious to one of ordinary skill in the art at the time of Applicant's invention, are therefore not unpatentable under 35 U.S.C. § 103(a), and therefore respectfully requests withdrawal of the rejection thereof under 35 U.S.C. § 103(a).

Applicant respectfully submits that this patent application is in condition for allowance. An early indication of the allowability of this application is therefore respectfully solicited.

If Mr. Prebilic believes that a telephone conference with the undersigned would expedite passage of this patent application to issue, he is invited to call on the number below.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. If, however, additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and the Commissioner is hereby authorized to charge fees necessitated by this paper, and to credit all refunds and overpayments, to our Deposit Account 50-2821.

Respectfully submitted,

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